REMARKS

Claims 1-29 are pending in the application. Claims 1-29 have been rejected under 35 U.S.C. §103(a) as being deemed unpatentable over Applicants Admitted Prior Art (AAPA) in view of U.S. Patent No. 6,681,334 (Nakamura) in further view of U.S. Patent No. 6,058,455 (Islam et al.). Of the Claims, Claims 1, 9, 17 and 25 are independent. Claims have been amended to clarify the Applicants' invention. The application as amended and argued herein, is believed to overcome the rejections.

Regarding Rejections under 35 U.S.C. § 103(a)

Claims 1-29 have been rejected under 35 U.S.C. §103(a) as being deemed unpatentable over Applicants Admitted Prior Art (AAPA) in view of U.S. Patent No. 6,681,334 (Nakamura) in further view of U.S. Patent No. 6,058,455 (Islam et al.).

Turning to the cited references, Nakamura discusses a power saving signal that allows a computer coupled to a flexible disk drive to control the power consumed by the flexible disk drive. (*See,* Abstract.)

Islam discusses performing a check for synchronization of physical configuration data for a RAID system when the system is initially powered on. (*See* col. 4, lines 42-46.)

To establish a prima facie case for obviousness under 35 U.S.C. 103(a), (1) there must be some suggestion or motivation to combine reference teachings; (2) there must be a reasonable expectation of success; (3) the references when combined must teach or suggest all the claim limitations. For the reasons discussed below, it is respectfully submitted that the Office has not established a prima facie case under 35 U.S.C. 103(a) for claims 1-29 and that therefore, claims 1-29 are allowable.

The references when combined do not teach or suggest all the claim limitations

If none of the references teach a claimed element, as shown by addressing each reference individually, then the combination of the references does not contain the claimed element. Thus, even if the references are combined, all of the claim elements are not shown in the combination of the cited references.

Nakimura does not teach or suggest at least:

"if a change in configuration of a Redundant Array of Inexpensive Disks (RAID) system occurs during a suspend mode of operation of a device coupled to the RAID system, storing, in the RAID system, data indicative, at least in part, of resulting configuration of the RAID system resulting after the change"

as claimed by the Applicants in Claim 1.

Nakimura discusses a flexible disk drive coupled to a computer (PC). The flexible disk drive provides an indication as to presence of a disk cartridge in the flexible disk drive. (*See* Fig. 2, (A) suspend/resume, (E) disk (in/out); Fig. 1, sensor means (12), sensor switch (13), disk cartridge (6), turntable (11).) There is no teaching or suggestion of at least "a change of configuration of a Redundant Array of Inexpensive Disks (RAID system" or "a suspend mode of operation of a device coupled to the RAID system" as claimed by the Applicants. In contrast to the Applicants' claimed "RAID system" and "suspend mode of operation of a device coupled to the RAID system", Nakumura merely discusses a flexible disk drive that may be in one of two states dependent on whether a disk cartridge is loaded in the flexible disk drive.

Nakamura's suspend/resume signal generated by the flexible disk drive in response to commands from the PC and is associated with state of the flexible disk drive not the state of the PC that is coupled to the flexible disk drive. (*See*, Fig. 4, suspend/resume signal generator means 35; Fig. 3, main network 31 and col. 6, lines 1-9 and lines 31-48.) Thus, Nakumura's suspend/resume signal does not teach or suggest "suspend mode of operation of a device coupled to the RAID system". Nakumura's suspend/resume signal is associated with the mode of operation of the flexible disk drive not the mode of operation of the PC that is coupled to the flexible disk drive (FDD). (*See,* Fig. 1, USB-FDD (1), PC (2).)

Islam discusses synchronization of physical configuration data for a RAID system at power on. (*See* col. 4, lines 42-46.) There is no discussion of "a suspend mode of operation of a device coupled to the RAID system". In contrast, Islam merely discusses synchronization of physical configuration data at power on.

The Office fails to identify a suggestion or motivation to combine reference teachings

"The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990.)" (*See* MPEP 2143.01 III.)

The Office fails to identify a suggestion or motivation in the prior art for combining AAPA, Nakamura and Islam. The Office action merely states: "a routineer in the art would have been motivated to look for a teaching for the possible method of detecting a change while the device is operating in a suspend mode." There must be actual evidence of a suggestion to modify a prior art reference or to combine two prior art references, and the suggestion to combine or modify the prior art must be clear and particular. (See In re Dembiczak, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999).)

The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." In re Fritch, 23 U.S.P.Q.2d 1780, 1783-84 (Fed. Cir. 1992)(emphasis added). The Office action does not identify any evidence in the prior art indicating or in any way suggesting the desirability of the proposed modifications.

Furthermore, AAPA and Islam are directed to a RAID system, and Nakamura is directed to a flexible disk drive coupled to a computer. One of ordinary skill in the art of RAID systems would not look to flexible disk drives for "if a change in configuration of a Redundant Array of Inexpensive Disks (RAID) system occurs during a suspend mode of operation of a device coupled to the RAID system" as claimed by the Applicants in claim 1.

Therefore, separately or in combination, AAPA, Islam and Nakimura do not teach or suggest the Applicants' claimed invention. Even if combined, the present invention as now claimed does not result as argued above.

Claims 1-8 are dependent claims that depend directly or indirectly on claim 1, which has been shown to be non-obvious over the cited art. Independent claims 9, 17 and 25 recite a like distinction and are thus non-obvious over the cited art. Claims 10-16 depend directly or indirectly on claim 9, claims 18-24 depend directly or indirectly on claim 17 and claims 25-29 depend directly or indirectly on claim 25 and are thus non-obvious over the cited references.

Accordingly, the present invention as now claimed is not believed to be made obvious from the cited references. Removal of the rejections under 35 U.S.C. § 103(a) and acceptance of claims 1-29 is respectfully requested.

CONCLUSION

In view of the foregoing, it is submitted that all claims (claims 1-29) are in condition of allowance. The Examiner is respectfully requested to contact the undersigned by telephone if such contact would further the examination of the above-referenced application.

Please charge any shortages and credit any overcharges to Deposit Account Number 50-0221.

Respectfully submitted,

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